

REMARKS

The above Amendments and these Remarks are in reply to the final Office Action mailed January 6, 2006. An appropriate Petition for Extension of Time to Respond is submitted herewith, together with the appropriate fee.

Claims 60-67, 97, 106 and 108-118 were pending in the Application prior to the outstanding Office Action. In the Office Action, the Examiner rejected claims 60-66, 97, 106, 108-110 and 112-118, and objected to claims 67 and 111. The present Response C amends claims 60, 114, 117 and 118, and cancels claims 115 and 116, leaving for the Examiner's present consideration claims 60-67, 97, 106, 108-114, 117, and 118. Applicants respectfully request reconsideration of the rejections.

I. REJECTION UNDER 35 U.S.C. §102(B) OVER *VOYDEVILLE GILLES* (FR. PAT. NO. FR2724554)

Claims 60, 61, 109, 112 and 114-116

The Examiner rejected claims 60, 61, 109, 112 and 114-116 under 35 U.S.C. §102(b) over *Voydeville*. Although Applicants respectfully take the position that features of claims 115 and 116 define claims 115 and 116 over the prior art, in the interest of furthering prosecution, Applicants request cancellation of claims 115 and 116. Applicants respectfully traverse the rejection of claims 60, 61, 109, 112, and 114.

In the Office Action, the Examiner writes that *Voydeville* discloses an implant comprising "a 'shaft' 2; a compressible cylindrical spacer 1 rotatably mounted on the 'shaft' 2" (Emphasis Added). See OA, page 2. However, nowhere does *Voydeville* disclose, or even teach or suggest, an implant comprising a "shaft disposed along a longitudinal axis...wherein the spacer is adapted to be inserted between the spinous processes in a direction along the longitudinal axis" as recited in claims 60 and 114.

Referring to FIG. 3 *Voydeville* discloses a block arranged between adjacent spinous processes. As can be seen from the figure, the block can be positioned between the adjacent spinous processes by insertion from the side or from a posterior to anterior direction. However, where the artificial ligaments (2) are taken to be a shaft, as suggested by the Examiner, the block cannot be "inserted between the spinous processes in a direction along the longitudinal axis." Such an arrangement as taught by *Voydeville* can be disadvantageous, as it requires the artificial ligaments to be arranged with additional effort than just the effort of inserting the block between the spinous processes. For example, the arrangement of *Voydeville* may require over-distraction and positioning of ligaments protruding from the insertion side of the block to be threaded prior to insertion of the block itself.

Since *Voydeville* fails to disclose all of the features of claims 60 and 114, and therefore *Voydeville* cannot anticipate claims 60 and 114 under 35 U.S.C. § 102(b). Dependent claims have at least the features of the independent claims from which they depend; therefore, *Voydeville* cannot anticipate claims

61, 109 and 112 (which ultimately depend from claim 60) under 35 U.S.C. § 102(b). Accordingly, Applicant respectfully requests withdrawal of the rejection.

II. REJECTION UNDER 35 U.S.C. §103(A) OVER *VOYDEVILLE*

Claims 62-66, 97, 106, 108, 110, 113, 117 and 118

The Examiner rejected claims 62-66, 97, 106, 108, 110, 113, 117 and 118 under 35 U.S.C. §103(a) as being unpatentable over *Voydeville*. Applicants respectfully traverse the rejection.

In the Office Action, the Examiner writes that “as previously discussed, *Voydeville* shows a device that basically the same as that recited in the above listed claims.” See OA, page 3. For the reasons given above in Section I, Applicants assert that *Voydeville* does not teach or suggest all of the features of claims 60, 61, 109, 112, 114, 117 and 118.

Voydeville fails to teach or suggest a “shaft disposed along a longitudinal axis...wherein the spacer is adapted to be inserted between the spinous processes in a direction along the longitudinal axis” as recited in claims 60, 114, 117 and 118. Since *Voydeville* fails to teach or suggest all of the features of claims 60, 114, 117 and 118, *Voydeville* cannot render claims 60, 114, 117 and 118 obvious under 35 U.S.C. § 103(a). Dependent claims have at least the features of the independent claims from which they depend; therefore, *Voydeville* cannot render claims 62-66, 97, 106, 108, 110 and 113 (which ultimately depend from claim 60) obvious under 35 U.S.C. § 103(a). Accordingly, Applicant respectfully requests withdrawal of the rejection.

III. ALLOWABLE SUBJECT MATTER

Applicants appreciate the indication that claims 67 and 111 are objected to as being dependent upon a rejected base claim, but would be allowable if amended to include the limitations of the base claim and any intervening claims. However, given the argument above, Applicants respectfully assert that claims 67 and 111 depend from allowable claims. Applicants respectfully request withdrawal of the objection.

IV. CONCLUSION

In light of the above, it is respectfully submitted that all of the claims now pending in the subject patent application should be allowable, and a Notice of Allowance is requested. The Examiner is respectfully requested to telephone the undersigned if he can assist in any way in expediting issuance of a patent.

The Commissioner is authorized to charge any underpayment or credit any overpayment to Deposit Account No. 06-1325 for any matter in connection with this response, including any fee for extension of time, which may be required.

Respectfully submitted,

Date: 6/06/06

By: 

Michael L. Robbins
Reg. No. 54,774

Customer No. 23910
FLIESLER MEYER LLP
Four Embarcadero Center, Fourth Floor
San Francisco, California 94111-4156
Telephone: (415) 362-3800